



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

M 27

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,190	08/31/2001	Daniel M. Wing	1242.017	1208

7590 05/08/2003

John Pietrangelo
Heslin Rothenberg Farley & Mesiti P.C.
5 Columbia Circle
Albany, NY 12203

EXAMINER

DESANTO, MATTHEW F

ART UNIT PAPER NUMBER

3763

DATE MAILED: 05/08/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,190

Applicant(s)

WING ET AL

Examiner

Matthew F DeSanto

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-13, 22-40, 42-44, 48-51, 54 and 59-77 is/are pending in the application.
- 4a) Of the above claim(s) 27-30, 32-40, 42-44, 50 and 51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-13, 22-26, 48, 49, 54 and 59-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12. 6) ☐ Other:

DETAILED ACTION

Claim Objections

1. Claims 9 and 31 are objected to because of the following informalities: the functional statement set forth in a "whereby" clause does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim. In re Mason, 244 F.2d 733, 114 USPQ 127 (CCPA 1957). The examiner suggests changing "whereby" to wherein, if the applicant is trying to impose function language for the structure already recited. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The 112 rejection is withdrawn.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3763

4. Claims 9-13, 31, 48, 49, 59 - 64, 75, 76 are rejected under 35 U.S.C. 102(b) as being anticipated by Cox et al. (USPN 5290294).

Cox et al. disclosed a trocar assembly with a cannula (12) and an obturator (18) and a first and second bearing surface. (Figure 2). Wherein the first and second bearing surface slidably engage each other when rotating the obturator relative to the cannula.

As to claims 11-13, wherein the first or second bearing comprises an incline, and/or a boss and/or a linear and curvilinear surface. (Figure 2).

As to claims 48 and 49, wherein the first bearing surface is moveable relative to the cannula and the second bearing surface is moveable relative to the obturator. (Figure 2, and entire reference).

As to claims 59-61, 63, 64, 75 and 76 wherein the head assembly has a bearing surface, a fluid port with a valve.

5. Claims 9-13, 31, 48, 49, 54, 59-62 and 65 rejected under 35 U.S.C. 102(b) as being anticipated by Scwemberger (USPN 5997510).

Scwemberger discloses trocar assembly with a cannula and an obturator and a first and second bearing surface. Wherein the first and second bearing surface slidably engage each other when rotating the obturator relative to the cannula as well as wherein the first or second bearing comprises an incline, and/or a boss and/or a linear and curvilinear surface, and wherein the first bearing surface is moveable relative to the cannula and the second bearing surface is moveable relative to the obturator, and

Art Unit: 3763

wherein the head assembly has a bearing surface, a fluid port with a valve. (Entire reference)

6. Claims 9 – 13, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor (USPN 4405307).

Taylor discloses trocar assembly with a cannula and an obturator and a first and second bearing surface. Wherein the first and second bearing surface slidably engage each other when rotating the obturator relative to the cannula as well as wherein the first or second bearing comprises an incline, and/or a boss and/or a recess, and/or a linear and curvilinear surface. (Entire reference)

7. Claims 22-26, and 66-73 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al. (USPN 5807338).

Smith et al. discloses a trocar assembly with a cannula (112) and obturator (110),

As to claim 23, wherein the cannula is uniformly tapered from a second inside diameter, larger than the first inside diameter. (Figures 1, 14 and 18 and entire reference).

As to claim 24, wherein the first inside surface of the cannula is smooth and continuous. (Figures 1, 14 and 18 and entire reference).

As to claims 25, 26, wherein the obturator comprises a first tapered surface extending from the maximum diameter of the first end to the tip and a second tapered

Art Unit: 3763

surface extending from the maximum diameter to the outside of the shaft. (Figure 2, 5, and 12 and entire reference).

As to claims 66-68, 70-71, and 73 wherein the head assembly has a bearing surface (Figure 2 and 16), a fluid port with a valve. (Figures 14 and 16 and entire reference).

As to claim 69 wherein the head assembly comprises a seal. Figure 14.

As to claim 72 wherein the cannula is non-metallic, column 5, lines 8-19.

8. Claims 9, 10, 11, 13, 48, and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Flom et al. (5971960).

Flom et al. discloses a trocar assembly comprising a cannula and an obturator, wherein there is a first and second bearing surface, which rotate relative each other. (Figure 1, 3, 10, 11 and entire reference).

Response to Arguments

9. Applicant's arguments filed 3/3/03 have been fully considered but they are not persuasive.

10. The Dunlap et al. has been withdrawn, with regards to the Smith reference according to Figures 5 and 6 the outer diameter of the obturator is larger than the inner diameter of the cannula because of the slits at the end of the cannula to allow the knife to pass through. This is shown in reference number 200.

11. As to the Flom et al. reference the obturator is reference number 36 and the cannula is reference number 14. Therefore, the cannula and obturator have the locking

Art Unit: 3763

means and the obturator has a bearing surface and is in contact with the cannula directly.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F DeSanto whose telephone number is 1-703-305-3292. The examiner can normally be reached on Monday-Friday 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 1-703-308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are 1-703-872-9302 for regular communications and 1-703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 1-703-308-0858.



Matthew DeSanto
Art Unit 3763
May 5, 2003



BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700